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1 24. The computer-implemented subscription service of claim 23, wherein the
2 information relating to performance of the office administration task comprises a
3 computer file containing a transcription of the dictation [tape].

REMARKS

I. INTRODUCTION

Claims 1-29 were presented for examination. Claim 1 stands rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite because, in the Examiner's view, the claim does not accomplish what the preamble sets forth. *See* Office Action, April 12, 2000, ¶ 4. Claims 1-12 stand rejected under 35 U.S.C. § 101 as lacking patentable utility because, in the Examiner's view, claim 1 only lists component parts without linkages to make up a practical application. *Id.*, ¶ 6.

In addition, claims 1, 3, 5, 7, 9 and 11-12 stand further rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,974,389 ("Clark"). *Id.*, ¶ 8. Claims 13 and 19-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,946,659 ("Lancelot"). *Id.*, ¶ 9. Claims 22-29 stand rejected under 35 U.S.C. § 102(a) as being anticipated by MedicaLogic's "Logician" application and related products, as disclosed in the following references: four MedicaLogic press releases respectively dated January 27, 1997, February 17, 1997, October 27, 1997, and November 10, 1997; Lynne Dunbrack, "Practice-Management Market to Reach \$1 Billion by 1999," Health Management Technology, June 1996, 31-34 ("Dunbrack"); and Ellen Messmer, "MedicaLogic Readies Distributed Patient Information Software," Network World, June 5, 1995, 37 ("Messmer"). *Id.*, ¶ 10.

In addition, claims 2, 4, 6, 8 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark in view of Ornstein, "Computerized Patient Record Systems: A Survey of 28 Vendors," Family Practice Management, Nov./Dec. 1998. *Id.*, ¶ 12. Claims 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancelot in view of U.S. Patent No. 5,146,439 ("Jachmann"). *Id.*, ¶ 13. Finally, claim 18 stands further rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancelot

in view of Jachmann and Mary K. Kerrigan, "A New Profit Center," Computers in Healthcare, Dec. 1987, 33-36 ("Kerrigan"). *Id.*, ¶ 14.

The Applicant has amended claims 1-11, 13-14, 19 and 22-24 to more clearly recite the subject matter of the claimed invention, as well as to traverse the rejections based on the form of the claims. Claims 1-29 thus remain in the application for consideration.

The Applicant respectfully submits that each of the pending claims is patentably distinguishable over the prior art of record and satisfies the other conditions for patentability under which they stand rejected. None of the references, whether taken alone or in combination, discloses the Applicant's claimed system and method for automating administrative procedures in a medical office.

II. THE NON-ART REJECTIONS

A. The Section 112, Paragraph 2 Rejection

The Applicant respectfully submits that the foregoing amendment of claim 1 traverses the rejection of that claim under 35 U.S.C. § 112, ¶ 2. The body of the claim now plainly recites features directed to accomplishing what the preamble sets forth; namely, a system for automating administrative procedures in a medical office. For example, the claim recites "a control module including instructions *for automated performance of a plurality of administrative tasks.*" Claim 1, ln. 3-4 (emphasis added). The Applicant therefore requests reconsideration and withdrawal of the rejection.

B. The Section 101 Rejections

The Applicant also respectfully submits that the foregoing amendment of claim 1 traverses the rejection of claims 1-12 under 35 U.S.C. § 101. Claim 1 now plainly recites the linkages between the various components recited therein to make up the claimed computer-based system for automating administrative procedures in a medical office. For example, the claim recites that both the administrator module and the tape management module are under control of the control module, and that the database is accessible by both the administrator module and the tape management module. Claim 1,

ln. 5-12. The Applicant therefore requests reconsideration and withdrawal of the rejection.

III. THE ART REJECTIONS

A. The Section 102 Rejections

1. Claims 1, 3, 5, 7, 9 and 11-12

Claims 1, 3, 5, 7, 9 and 11-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Clark. Clark describes an information management system for maintaining patient records, providing a central repository for patient information that can be accessed from a plurality of different user computers (e.g., doctor, nurse, transcriber, insurance administrator) for purposes of input or output. *See, e.g., Clark, col. 3, ln. 41-50; col. 4, ln. 10-30.* In contrast to the Applicant's claimed invention, however, Clark does not describe using this information management system to automate administrative procedures.

Pending claim 1 is directed to a system for automating administrative procedures comprising, in pertinent part, "a control module *including instructions for controlling automated performance of a plurality of administrative tasks,*" "an administrator module . . . *including instructions for automated generation of administrative reports,*" and "a tape management module . . . *including instructions for automated management of tape transcription services.*" Claim 1, ln. 5-10 (emphasis added). Clark fails to disclose any of these features. For example, rather than providing for automated generation of administrative reports, Clark simply notes that the stored patient information can be used by an outside agency for report generation. *See Clark, col. 4, ln. 46-53.* Likewise, rather than providing for automated management of tape transcription services, Clark simply discloses that a transcriber computer can be used to remotely update stored patient information. *See id., col. 4, ln. 18-23.* For at least these reasons, the Applicant respectfully submits that Clark fails to anticipate claim 1 or its dependent claims 3, 5, 7, 9 and 11-12.

2. Claims 13 and 19-21

Claims 13 and 19-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lancelot. Much like Clark, Lancelot describes a clinical information system in which patient information is maintained in a central database for access by a plurality of user computers. *See, e.g.*, Lancelot, col. 3, ln. 63 - col. 4, ln. 60. Also like Clark, Lancelot fails to describe using this clinical information system for "managing performance of one or more administrative tasks by an off-site service provider, including managing an electronic information exchange between the off-site service provider and the office automation system and reporting on tasks assigned to the off-site service provider," as in the claimed invention. *See* Claim 13, ln. 8-11; claim 19, ln. 9-12. Contrary to the Examiner's suggestion, the off-site support computer 49 of Lancelot is not used for this purpose, but rather serves the purpose of "provid[ing] information to remote locations." Clark, col. 5, ln. 50-52. For at least these reasons, the Applicant respectfully submits that independent claims 13 and 19 and dependent claims 20-21 are patentably distinguishable over Lancelot.

3. Claims 22-29

Claims 22-29 stand rejected under 35 U.S.C. § 102(a) as being anticipated by certain press releases and articles relating to MedicaLogic's "Logician" electronic medical record (EMR) software package. However, contrary to the Examiner's suggestion, the cited references do not describe using the Logician software to provide office administration services on a subscription basis as recited in claim 22. For example, claim 22 recites providing each of a plurality of subscribers with an office automation system, receiving requests for performance of an office administration task from such a system at a subscriber service center, performing the task at the subscriber service center, and then transmitting information back to the subscriber's office automation system. *See* Claim 22, ln. 5-12. By contrast, the discussions cited by the Examiner merely describe Logician as a software application that can be licensed by MedicaLogic's customers, and that such customers may use that software at multiple integrated locations.

As for the Examiner's citation to the discussion of the Reynolds and Reynolds R/2000 product in the Dunbrack article, the Applicant fails to find any discussion of providing office administration tasks on a subscription basis, whether using Logician, R/2000, or otherwise. While the article notes a proposed integration between Logician and R/2000, and states that "R/2000 has been implemented in almost 100 service bureaus," there is no disclosure of the above-discussed features recited in claim 22. Accordingly, the Applicant respectfully submits that claim 22 and its dependent claims 23-29 are patentably distinguishable over the prior art of record.

B. The Section 103 Rejections

1. Claims 2, 4, 6, 8 and 10

Claims 2, 4, 6, 8 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark as applied to claim 1 in connection with the above-discussed anticipation rejection, and further in view of Ornstein. However, for the reasons set forth above in traversing the anticipation rejection, the Applicant respectfully submits that the proposed combination of Clark and Ornstein would not lead a person of ordinary skill in the art to the Applicant's claimed invention because Ornstein does not provide the disclosure missing from Clark. The Applicant therefore respectfully submits that claims 2, 4, 6, 8 and 10 are patentably distinguishable over Clark in view of Ornstein.

2. Claims 14-18

Claims 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancelot as applied to claim 13 in connection with the above-discussed anticipation rejection, and further in view of Jachmann. However, for the reasons set forth above in traversing the anticipation rejection, the Applicant respectfully submits that the proposed combination of Lancelot and Jachmann would not lead a person of ordinary skill in the art to the Applicant's claimed invention because Jachmann does not provide the disclosure missing from Lancelot. The Applicant therefore respectfully submits that claims 14-18 are patentably distinguishable over Lancelot in view of Jachmann.

Claim 18 stands further rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancelot in view of Jachmann and Kerrigan. Again, for the same reasons set forth

above, the Applicant respectfully submits that the proposed combination of Lancelot, Jachmann and Kerrigan would not lead a person of ordinary skill in the art to the Applicant's claimed invention.

IV. CONCLUSION

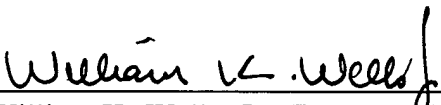
In view of the foregoing amendment and remarks, the Applicant respectfully submits that each of the pending claims is in condition for allowance, and requests early notice to that effect.

The Applicant invites the Examiner to contact the undersigned to discuss any matter concerning this application.

The Applicant hereby authorizes the Office to charge any fees or credit any overpayments arising from this communication to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,

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